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APR 16 2004

OFFICE OF PETITIONS

In re Application of :
Hayes and Young : DECISION REFUSING STATUS
Application No. 10/622,808 : UNDER 37 CFR 1.47(a)
Filed: 17 July, 2003 :
Atty Docket No. NPW 346 :

This is in response to the petition filed under 37 CFR 1.47(a) on 26 February, 2004.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.

Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 17 July, 2003, without an executed oath or declaration. Accordingly, on 26 November, 2003, a Notice to File Missing Parts of Nonprovisional Application was mailed, requiring the statutory basic filing fee, an executed oath or declaration, and a surcharge for their late filing.

In response, on 26 February, 2004, petitioners filed the present petition, the basic filing fee, a one (1) month extension of time, the late-filing surcharge, and a declaration naming Alan E. Hayes and Jerry A. Young as joint inventors, signed by joint inventor Hayes on behalf of himself and joint inventor Young.

Petitioners state that joint inventor Young cannot be reached or has refused to sign the declaration. The petition states that a copy of the application was sent to joint inventor Young, but was not returned. Petitioners have also enclosed a copy of a letter

sent to joint inventor Young's last known address, as well as a copy of the envelope in which it was sent, showing the letter was returned by the U.S. Postal Service as undeliverable.

A grantable petition under 37 CFR 1.47(a) requires:

(1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee;

(4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and

(5) a statement of the last known address of the non-signing inventor.

The petition lacks item (1).

In regards to item (1), petitioners have not provided proof that joint inventor Young was ever sent or presented with a copy of the application as filed (specification, including claims, drawings, if any, and the declaration).¹ While petitioners' registered patent attorney states in the petition that both Hayes and Young were provided with copies of the application and the Declaration, it is not clear if this statement is made with first-hand knowledge. The petition further states that a letter sent to Young at his last known address asking him to sign and return the declaration was returned as undeliverable by the USPS.

Furthermore, with regards to Young's unavailability, the showing of record, a single mailing, is not sufficient to show that diligent efforts were made to contact the non-signing inventor. Petitioners should attempt to determine the non-signing inventor's current address through e-mail, Internet, or other types of searches. If repeated attempts to contact the non-signing inventor are unsuccessful, petitioners will have shown that the non-signing inventor cannot be reached.

Petitioners may show proof that a copy of the application was sent or given to the non-signing inventor for review by providing a copy of the cover letter transmitting the application papers (specification, including claims, drawings, if any, and the

¹MPEP 409.03(d).

declaration) to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

Likewise, before a *bona fide* refusal to sign the declaration can be alleged, petitioners must show that a copy of the application was sent or given to the inventor. If the inventor refuses in writing, petitioners must submit a copy of that written refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of fact.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
 2011 South Clark Place
 Customer Window
 Crystal Plaza 2, Lobby, Room 1B03
 Arlington, VA 22202

Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.



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